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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,714	10/03/2000	Arnaud Vilbert	5725.0622	8388

7590 06/28/2002

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1300 I Street N W  
Washington, DC 20005

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/28/2002 17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/582,714

Applicant(s)

VILBERT, ARNAUD

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-71 is/are pending in the application.
- 4a) Of the above claim(s) 32-38, 42, 46-57, 59 and 70-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-31, 39-41, 43-45, 58 and 60-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 21-71 are pending. Claims 32-38, 42, 46-57, 59, 70-73 are withdrawn from consideration, as they are directed to non-elected subject matter. The Amendment filed May 3, 2002, cancelled claim 31, and amended claims 32, 36, 39, 41 and 42, and added claims 72-73.

#### ***Response to Applicant's Arguments/Amendment***

The Applicant's arguments filed May 3, 2002 (Paper No. 15) to the rejection of claims 27-31, 39-41, 43-45, 58 and 60-69 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Applicant's arguments and amendment filed May 3, 2002 (Paper No. 15) to the rejection of claims 31, 32, 36, 39, 41, 42, 46, 48, 51, 52, 54-57 and 59 made by the Examiner under 35 USC 112 have been fully considered and deemed persuasive-in-part. See below for details.

The Terminal Disclaimer filed May 3, 2002, Paper No. 16, is sufficient to overcome the double patenting rejections in the previous Office Action.

#### ***Election/Restrictions***

For the polycondensate, Applicant elected formula (I'), wherein X' is 0 and R is a C1-C20 cycloaliphatic radical. In Applicant's Response to Election of Species Requirement, no mention was made of polycondensates comprising compounds containing two active hydrogen atoms, substances comprising a diol containing an acid radical, isocyanates, or silicone compounds. Regarding the film-forming polymer, Applicant elected grafted silicone polymers comprising a polysilicone portion and a non-silicone organic chain portion. Claims 46-48 make no mention of grafted silicone polymers.

***112 Rejection Maintained***

The rejection of claim 41 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed December 5, 2001, Paper No. 13, and those found below.

(i) The rejection of claim 41 over the phrase “divalent radical derived from isophorone”, is maintained, as the metes and bounds of this claim are not clearly delineated. It would be impossible for one of ordinary skill in the art to be apprised of every divalent radical derived from isophorone. Additionally, on pages 18 and 19 of the specification, this phrase is not defined. Furthermore, the recitation of a few examples would not be sufficient to define this phrase.

***103 Rejection Maintained***

The rejection of claims 27-31, 39-41, 43-45, 58, and 60-69 under 35 U.S.C. 103(a) as being unpatentable over Mougin et al. (6,166,093), Mougin (5,643,581) or Mondet et al. (EP 751162) in view of Beitone et al. (5,653,963) is MAINTAINED for the reasons set forth in the Office Action mailed December 5, 2001, Paper No. 13, and those found below.

Applicant argues, “None of Mougin ‘093, Mougin ‘581 and Mondet references teaches or suggests a composition comprising at least one polycondensate and at least one film forming polymer”. This argument is not persuasive. It is respectfully pointed out that the polyurethane and/or polyurea polycondensation products of Mougin, Mougin and Mondet are also grafted silicone polymers comprising a polysiloxane portion and a non-silicone organic chain portion. For example, see Col. 2 of ‘093, lines 56-60, which states “The polyurethane and/or polyurea block polycondensation products used according to the invention are characterized in that their

chain is formed by the repetition of at least one polyurethane and/or polyurea block comprising a polysiloxane graft”.

### ***Unexpected Results***

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, there are no unexpected results.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
June 13, 2002

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